

Union Calendar No. 508

106TH CONGRESS
2D SESSION

H. R. 4870

[Report No. 106–853]

To make technical corrections in patent, copyright, and trademark laws.

IN THE HOUSE OF REPRESENTATIVES

JULY 18, 2000

Mr. COBLE (for himself and Mr. BERMAN) introduced the following bill; which
was referred to the Committee on the Judiciary

SEPTEMBER 14, 2000

Reported with an amendment, committed to the Committee of the Whole
House on the State of the Union, and ordered to be printed

[Strike out all after the enacting clause and insert the part printed in italic]

[For text of introduced bill, see copy of bill as introduced on July 18, 2000]

A BILL

To make technical corrections in patent, copyright, and
trademark laws.

1 *Be it enacted by the Senate and House of Representa-*
2 *tives of the United States of America in Congress assembled,*

3 **SECTION 1. SHORT TITLE.**

4 *This Act may be cited as the “Intellectual Property*
5 *Technical Amendments Act of 2000”.*

1 **SEC. 2. OFFICERS AND EMPLOYEES.**

2 (a) *RENAMING OF OFFICERS.*—(1) *Title 35, United*
3 *States Code, is amended—*

4 (A) *by striking “Director” each place it appears*
5 *and inserting “Commissioner”; and*

6 (B) *by striking “Director’s” each place it ap-*
7 *pears and inserting “Commissioner’s”.*

8 (2) *The Act of July 5, 1946 (commonly referred to as*
9 *the “Trademark Act of 1946”; 15 U.S.C. 1051 et seq.) is*
10 *amended by striking “Director” each place it appears and*
11 *inserting “Commissioner”.*

12 (3) *Title 35, United States Code, is amended by strik-*
13 *ing “Commissioner for Patents” each place it appears and*
14 *inserting “Assistant Commissioner for Patents”.*

15 (4) *Title 35, United States Code, is amended by strik-*
16 *ing “Commissioner for Trademarks” each place it appears*
17 *and inserting “Assistant Commissioner for Trademarks”.*

18 (5) *Section 5314 of title 5, United States Code, is*
19 *amended by striking*

20 *“Under Secretary of Commerce for Intellectual*
21 *Property and Director of the United States Patent*
22 *and Trademark Office.”*

23 *and inserting*

24 *“Under Secretary of Commerce for Intellectual*
25 *Property and Commissioner of the United States Pat-*
26 *ent and Trademark Office.”*

1 (b) *REFERENCES*.—Any reference in any other Federal
2 law, Executive order, rule, regulation, or delegation of au-
3 thority, or any document of or pertaining to the Patent and
4 Trademark Office—

5 (1) to the Director of the United States Patent
6 and Trademark Office or to the Commissioner of Pat-
7 ents and Trademarks is deemed to refer to the Under
8 Secretary of Commerce for Intellectual Property and
9 Commissioner of the United States Patent and Trade-
10 mark Office;

11 (2) to the Commissioner for Patents is deemed to
12 refer to the Assistant Commissioner for Patents; and

13 (3) to the Commissioner for Trademarks is
14 deemed to refer to the Assistant Commissioner for
15 Trademarks.

16 **SEC. 3. ADJUSTMENT OF TRADEMARK FEES.**

17 Section 4203 of the Intellectual Property and Commu-
18 nications Omnibus Reform Act of 1999, as enacted by sec-
19 tion 1000(a)(9) of Public Law 106–113, is amended by
20 striking “Director” and inserting “Commissioner”.

1 **SEC. 4. OPTIONAL INTER PARTES REEXAMINATION PROCE-**
2 **DURE ACT OF 1999; TECHNICAL AMEND-**
3 **MENTS.**

4 (a) *OPTIONAL INTER PARTES REEXAMINATION PRO-*
5 *CEDURES.*—*Title 35, United States Code, is amended as fol-*
6 *lows:*

7 (1) *Section 311 is amended—*

8 (A) *in subsection (a), by striking “person”*
9 *and inserting “third-party requester”; and*

10 (B) *in subsection (c), by striking “Unless*
11 *the requesting person is the owner of the patent,*
12 *the” and inserting “The”.*

13 (2) *Section 312 is amended—*

14 (A) *in subsection (a), by striking the last*
15 *sentence; and*

16 (B) *by striking “, if any”.*

17 (3) *Section 314(b)(1) is amended—*

18 (A) *by striking “(1) This” and all that fol-*
19 *lows through “(2)” and inserting “(1)”;*

20 (B) *by striking “the third-party requester*
21 *shall receive a copy” and inserting “the Office*
22 *shall send to the third-party requester a copy”;*
23 *and*

24 (C) *by redesignating paragraph (3) as*
25 *paragraph (2).*

1 (4) *Section 315(c) is amended by striking*
 2 *“United States Code,”.*

3 (5) *Section 317 is amended—*

4 (A) *in subsection (a), by striking “patent*
 5 *owner nor the third-party requester, if any, nor*
 6 *privies of either” and inserting “third-party re-*
 7 *quester nor its privies”, and*

8 (B) *in subsection (b), by striking “United*
 9 *States Code,”.*

10 (b) *CONFORMING AMENDMENTS.—Subsections (a), (b),*
 11 *and (c) of section 134 of title 35, United States Code, are*
 12 *each amended by striking “administrative patent judge”*
 13 *each place it appears and inserting “primary examiner”.*

14 (c) *CLERICAL AMENDMENTS.—*

15 (1) *Section 4604(a) of the Intellectual Property*
 16 *and Communications Omnibus Reform Act of 1999,*
 17 *is amended by striking “Part 3” and inserting “Part*
 18 *III”.*

19 (2) *Section 4604(b) of that Act is amended by*
 20 *striking “title 25” and inserting “title 35”.*

21 (d) *EFFECTIVE DATE.—The amendments made by sec-*
 22 *tions 4605(c) and 4605(e) of the Intellectual Property and*
 23 *Communications Omnibus Reform Act, as enacted by sec-*
 24 *tion 1000(a)(9) of Public Law 106–113, shall apply to any*
 25 *reexamination filed in the United States Patent and Trade-*

1 mark Office on or after the date of the enactment of Public
2 Law 106–113.

3 **SEC. 5. PATENT AND TRADEMARK EFFICIENCY ACT AMEND-**
4 **MENTS.**

5 (a) *DEPUTY DIRECTOR.*—

6 (1) Section 5315 of title 5, United States Code,
7 is amended by striking “Deputy Under Secretary of
8 Commerce for Intellectual Property and Deputy Di-
9 rector of the United States Patent and Trademark Of-
10 fice.”.

11 (2) Section 17(b) of the Act of July 5, 1946
12 (commonly referred to as the “Trademark Act of
13 1946”) (15 U.S.C. 1067(b)), is amended by inserting
14 “the Deputy Commissioner,” after “Commissioner,”.

15 (3) Section 6(a) of title 35, United States Code,
16 is amended by inserting “the Deputy Commissioner,”
17 after “Commissioner,”.

18 (b) *PUBLIC ADVISORY COMMITTEES.*—Section 5 of
19 title 35, United States Code, is amended by adding at the
20 end the following new subsection:

21 “(j) *INAPPLICABILITY OF PATENT PROHIBITION.*—Sec-
22 tion 4 shall not apply to voting members of the Advisory
23 Committees.”.

1 (c) *CHIEF FINANCIAL OFFICER*.—Section 901(b)(2) of
 2 title 31, United States Code, is amended by adding at the
 3 end the following new subparagraph:

4 “(I) The United States Patent and Trademark
 5 Office.”.

6 (d) *MISCELLANEOUS*.—Section 153 of title 35, United
 7 States Code, is amended by striking “and attested by an
 8 officer of the Patent and Trademark Office designated by
 9 the Commissioner,”.

10 **SEC. 6. DOMESTIC PUBLICATION OF FOREIGN FILED PAT-**
 11 **ENT APPLICATIONS ACT OF 1999 AMEND-**
 12 **MENTS.**

13 Section 154(d)(4)(A) of title 35, United States Code,
 14 as in effect on November 29, 2000, is amended—

15 (1) by striking “on which the Patent and Trade-
 16 mark Office receives a copy of the” and inserting
 17 “of”; and

18 (2) by striking “international application” the
 19 last place it appears and inserting “publication”.

20 **SEC. 7. DOMESTIC PUBLICATION OF PATENT APPLICATIONS**
 21 **PUBLISHED ABROAD.**

22 Subtitle E of title IV of the Intellectual Property and
 23 Communications Omnibus Reform Act of 1999, as enacted
 24 by section 1000(a)(9) of Public Law 106–113, is amended
 25 as follows:

1 (1) *Section 4505 is amended to read as follows:*

2 **“SEC. 4505. PRIOR ART EFFECT OF PUBLISHED APPLICA-**
3 **TIONS.**

4 *“Section 102(e) of title 35, United States Code, is*
5 *amended to read as follows:*

6 *“‘(e) the invention was described in (1) an application*
7 *for patent, published under section 122(b), by another filed*
8 *in the United States before the invention by the applicant*
9 *for patent or (2) a patent granted on an application for*
10 *patent by another filed in the United States before the in-*
11 *vention by the applicant for patent, except that an inter-*
12 *national application filed under the treaty defined in sec-*
13 *tion 351(a) shall have the effects for the purposes of this*
14 *subsection of an application filed in the United States if*
15 *and only if the international application designated the*
16 *United States and was published under Article 21(2) of*
17 *such treaty in the English language; or’”.*

18 (2) *Section 4507 is amended—*

19 (A) *in paragraph (1), by striking “Section*
20 11” and inserting “Section 10”;

21 (B) *in paragraph (2), by striking “Section*
22 12” and inserting “Section 11”.

23 (C) *in paragraph (3), by striking “Section*
24 13” and inserting “Section 12”;

1 (D) in paragraph (4), by striking “12 and
2 13” and inserting “11 and 12”;

3 (E) in section 374 of title 35, United States
4 Code, as amended by paragraph (10), by striking
5 “confer the same rights and shall have the same
6 effect under this title as an application for pat-
7 ent published” and inserting “be deemed a publi-
8 cation”; and

9 (F) by adding at the end the following:

10 “(12) The item relating to section 374 in the
11 table of contents for chapter 37 of title 35, United
12 States Code, is amended to read as follows:

 “374. Publication of international application.”.

13 (3) Section 4508 is amended to read as follows:

14 **“SEC. 4508. EFFECTIVE DATE.**

15 “Except as otherwise provided in this section, sections
16 4502 through 4507, and the amendments made by such sec-
17 tions, shall take effect on November 29, 2000, and shall
18 apply only to applications (including international appli-
19 cations designating the United States) filed on or after that
20 date. The amendments made by sections 4504 and 4505
21 shall additionally apply to any pending application filed
22 before November 29, 2000, if such pending application is
23 published pursuant to a request of the applicant under such
24 procedures as may be established by the Director. If an ap-
25 plication is filed on or after November 29, 2000, or is pub-

1 *lished pursuant to a request from the applicant, and the*
 2 *application claims the benefit of one or more prior-filed ap-*
 3 *plications under section 119(e), 120, or 365(c) of title 35,*
 4 *United States Code, then the provisions of section 4505 shall*
 5 *apply to the prior-filed application in determining the fil-*
 6 *ing date in the United States of the application.”.*

7 **SEC. 8. MISCELLANEOUS CLERICAL AMENDMENTS.**

8 (a) *AMENDMENTS TO TITLE 35.—The following provi-*
 9 *sions of title 35, United States Code, are amended:*

10 (1) *Section 2(b) is amended in paragraphs*
 11 *(2)(B) and (4)(B), by striking “, United States*
 12 *Code”.*

13 (2) *Section 3 is amended—*

14 (A) *in subsection (a)(2)(B), by striking*
 15 *“United States Code,”;*

16 (B) *in subsection (b)(2)—*

17 (i) *in the first sentence of subpara-*
 18 *graph (A), by striking “, United States*
 19 *Code”;*

20 (ii) *in the first sentence of subpara-*
 21 *graph (B)—*

22 (I) *by striking “United States*
 23 *Code,”; and*

24 (II) *by striking “, United States*
 25 *Code”;*

1 (iii) in the second sentence of subpara-
2 graph (B)—

3 (I) by striking “United States
4 Code,”; and

5 (II) by striking “, United States
6 Code.” and inserting a period;

7 (iv) in the last sentence of subpara-
8 graph (B), by striking “, United States
9 Code”; and

10 (v) in subparagraph (C), by striking “,
11 United States Code”; and

12 (C) in subsection (c)—

13 (i) in the subsection caption, by strik-
14 ing “, UNITED STATES CODE”; and

15 (ii) by striking “United States Code.”.

16 (3) Section 5 is amended in subsections (e) and
17 (g), by striking “, United States Code” each place it
18 appears.

19 (4) The table of chapters for part I is amended
20 in the item relating to chapter 3, by striking “**be-**
21 **fore**” and inserting “**Before**”.

22 (5) The item relating to section 21 in the table
23 of contents for chapter 2 is amended to read as fol-
24 lows:

“21. Filing date and day for taking action.”.

1 (6) *The item relating to chapter 12 in the table*
 2 *of chapters for part II is amended to read as follows:*

“12. Examination of Application 131”.

3 (7) *The item relating to section 116 in the table*
 4 *of contents for chapter 11 is amended to read as fol-*
 5 *lows:*

“116. Inventors.”.

6 (8) *Section 154(b)(4) is amended by striking “,*
 7 *United States Code,”.*

8 (9) *Section 156 is amended—*

9 (A) *in subsection (b)(3)(B), by striking*
 10 *“paragraphs” and inserting “paragraph”;*

11 (B) *in subsection (d)(2)(B)(i), by striking*
 12 *“below the office” and inserting “below the Of-*
 13 *fice”;* and

14 (C) *in subsection (g)(6)(B)(iii), by striking*
 15 *“submitted” and inserting “submitted”.*

16 (10) *The item relating to section 183 in the table*
 17 *of contents for chapter 17 is amended by striking “of”*
 18 *and inserting “to”.*

19 (11) *Section 185 is amended by striking the sec-*
 20 *ond period at the end of the section.*

21 (12) *Section 201(a) is amended—*

22 (A) *by striking “United States Code,”; and*

23 (B) *by striking “5, United States Code.”*
 24 *and inserting “5.”.*

1 (13) *Section 202 is amended—*

2 (A) *in subsection (b)(4), by striking “last*
3 *paragraph of section 203(2)” and inserting “sec-*
4 *tion 203(b)”*; and

5 (B) *in subsection (c)—*

6 (i) *in paragraph (4) by striking*
7 *“rights;” and inserting “rights,”*; and

8 (ii) *in paragraph (5) by striking “of*
9 *the United States Code”*.

10 (14) *Section 203 is amended—*

11 (A) *in paragraph (2)—*

12 (i) *by striking “(2)” and inserting*
13 *“(b)”*;

14 (ii) *by striking the quotation marks*
15 *and comma before “as appropriate”*; and

16 (iii) *by striking “paragraphs (a) and*
17 *(c)” and inserting “paragraphs (1) and (3)*
18 *of subsection (a)”*; and

19 (B) *in the first paragraph—*

20 (i) *by striking “(a)”, “(b)”, “(c)”, and*
21 *(d)” and inserting “(1)”, “(2)”, “(3)”, and*
22 *(4)”*, respectively; and

23 (ii) *by striking “(1.” and inserting*
24 *“(a)”*.

1 (15) *Section 209 is amended in subsections (a)*
 2 *and (f)(1), by striking “of the United States Code”.*

3 (16) *Section 210 is amended—*

4 *(A) in subsection (a)—*

5 *(i) in paragraph (11), by striking*
 6 *“5901” and inserting “5908”; and*

7 *(ii) in paragraph (20) by striking*
 8 *“178(j)” and inserting “178j”; and*

9 *(B) in subsection (c)—*

10 *(i) by striking “paragraph 202(c)(4)”*
 11 *and inserting “section 202(c)(4)”; and*

12 *(ii) by striking “title..” and inserting*
 13 *“title.”.*

14 (17) *The item relating to chapter 29 in the table*
 15 *of chapters for part III is amended by inserting a*
 16 *comma after “**Patent**”.*

17 (18) *The item relating to section 256 in the table*
 18 *of contents for chapter 25 is amended to read as fol-*
 19 *lows:*

“256. *Correction of named inventor.*”.

20 (19) *Section 294 is amended—*

21 *(A) in subsection (b), by striking “United*
 22 *States Code,”; and*

23 *(B) in subsection (c), in the second sentence*
 24 *by striking “court to” and inserting “court of”.*

1 (20)(A) *The item relating to section 374 in the*
 2 *table of contents for chapter 37 is amended to read as*
 3 *follows:*

“374. Publication of international application.”.

4 (B) *The amendment made by subparagraph (A)*
 5 *shall take effect on November 29, 2000.*

6 (21) *Section 371(b) is amended by adding at the*
 7 *end a period.*

8 (22) *Section 371(d) is amended by adding at the*
 9 *end a period.*

10 (23) *Paragraphs (1), (2), and (3) of section*
 11 *376(a) are each amended by striking the semicolon*
 12 *and inserting a period.*

13 (b) *OTHER AMENDMENTS.—*

14 (1) *Section 4732(a) of the Intellectual Property*
 15 *and Communications Omnibus Reform Act of 1999 is*
 16 *amended—*

17 (A) *in paragraph (9)(A)(ii), by inserting*
 18 *“in subsection (b),” after “(ii)”;* *and*

19 (B) *in paragraph (10)(A), by inserting*
 20 *after “title 35, United States Code,” the fol-*
 21 *lowing: “other than sections 1 through 6 (as*
 22 *amended by chapter 1 of this subtitle),”.*

23 (2) *Section 4802(1) of that Act is amended by*
 24 *inserting “to” before “citizens”.*

25 (3) *Section 4804 of that Act is amended—*

1 (A) in subsection (b), by striking “11(a)”
2 and inserting “10(a)”; and

3 (B) in subsection (c), by striking “13” and
4 inserting “12”.

5 (4) Section 4402(b)(1) of that Act is amended by
6 striking “in the fourth paragraph”.

7 **SEC. 9. TECHNICAL CORRECTIONS IN TRADEMARK LAW.**

8 (a) *AWARD OF DAMAGES*.—Section 35(a) of the Act
9 of July 5, 1946 (commonly referred to as the “Trademark
10 Act of 1946”) (15 U.S.C. 1117(a)), is amended by striking
11 “a violation under section 43(a), (c), or (d),” and inserting
12 “a violation under section 43(a) or (d),”.

13 (b) *CLERICAL AMENDMENTS*.—The Trademark Act of
14 1946 is further amended as follows:

15 (1) Section 1(d)(1) is amended in the first sen-
16 tence by striking “specifying the date of the appli-
17 cant’s first use” and all that follows through the end
18 of the sentence and inserting “specifying the date of
19 the applicant’s first use of the mark in commerce and
20 those goods or services specified in the notice of allow-
21 ance on or in connection with which the mark is used
22 in commerce.”.

23 (2) Section 23(c) is amended by striking the sec-
24 ond comma after “numeral”.

1 (3) *Section 33(b)(8) is amended by aligning the*
2 *text with paragraph (7).*

3 (4) *Sections 34(d)(11) and 35(b) are each*
4 *amended by striking “of 1954” and inserting “of*
5 *1986”.*

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